



**SNIDER & ASSOCIATES
INTELLECTUAL PROPERTY LAW
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This letter is to introduce you and your clients to this firm. The practice is limited to intellectual property and we represent Fortune 500 U.S. companies, small U.S. clients and many Japanese companies. Many of our Japanese corporate clients have recommended us to their Japanese patent attorneys who handle foreign filings for them.

Mr. Snider is the principal of Snider & Associates. Mr. Brown is the senior partner of Emrich & Dithmar, L.L.C. of Chicago Illinois, Mr. Krit is with Emrich & Dithmar, Mr. Marhoffer works in Mr. Snider's office, and Mr. Tockman works only for Mr. Snider and consults with the firm on all chemical cases. Since Emrich & Dithmar is a separate firm, all potential conflicts are carefully examined. Japanese clients will be consulted if there is any potential conflict question. Attached are each attorney's personal résumé.

Mr. Snider and all his associates have extensive experience in patent preparation, prosecution and patent office appeals. Mr. Brown and Mr. Snider both have extensive experience in litigation. With this background, we are always aware of the effect prosecution statements can have on subsequent litigation or licensing of a resulting patent.

The firm has a policy of never filing a new case on the last day if it can be avoided, always providing a draft of an amendment to be filed to the client before filing, and working closely with foreign associates at all times.

Mr. Snider's litigation background is extensive because that was his primary practice from 1969 until 1990 when the practice shifted to Patent Office related work. Attached is a summary of the cases which were reported in the U.S. There were many other non-reported cases as well. The most outstanding case was Lemelson v. Mossinghoff (copy attached). This case was an appeal of a rejection under 35 USC Sec. 103 from the U.S. Patent Office to the United States District Court for the District of Columbia. The case is unusual because discovery was taken against the Patent Office and because Mattel (maker of Hot Wheels) testified under subpoena in court because its corporate headquarters is Delaware, which is within 100 miles of the District of Columbia court. A copy of this case is attached.

Ronald R. Snider

EDUCATION AND TEACHING:

BSEE	Purdue University, 1960
LLB	University of Michigan, 1963
MBA	University of Michigan, 1965
LLM	Patent Law, George Washington University, 1971
	Masters Thesis: <i>Patent Accounting in the U.S. Court of Claims</i>

- Taught "International Licensing of Intellectual Property" at Georgetown University Law School (1983-1988)
- Patent Moot Court Judge, George Washington University Law School (1981-1985)

PROFESSIONAL EXPERIENCE:

- 1979 to present -- Private practice in Washington D.C.
Snider & Associates, present
 - Snider & Chao (1997)
 - Townsend, Snider & Banta (1992)
 - Wegner & Bretschneider and Browdy & Niemark, Of Counsel (1983-1991)
 - Snider, Sterne & Saidman (1980)
 - Sughrue, Rothwell, et al, Associate (1977-1979)
- Trial Attorney, U.S. Department of Justice, Patent Section, Civil Division (1969-1976)
- Engineering positions, graduate schools and U.S. Patent Office Examiner (1960-1969)

LITIGATION EXPERIENCE:

- First chair responsibility in cases that comprise over 100 days of in-trial evidence presentation and another 50 days of oral argument and motions practice before trial and appellate judges. Second chair experience in two other trials.
- Assisted Paul Brown in obtaining a \$2.5 million judgment against U.S. Postal Service in U.S. Claims Court. Case is appealed to the Federal Circuit.
- Obtained a \$1.7 million settlement in favor of our client (contingent fee) in litigation against Kenyon & Kenyon (Washington) and Cesari & McKenna (Boston)
- Represented General Electric, United Technologies and Jerome H. Lemelson
- Represented the United States against General Electric Corp., Gould Corp., and Dynamics Corporation.
- Trial Attorney, U.S. Department of Justice, Patent Section, Civil Division (1969-1976). Won four cases.

PATENT PROSECUTION, PREPARATION, OPINIONS:

- Japanese prosecution for Shin-Etsu Semiconductor, Fuji Photo Optical, and Shiseido (cosmetics)
- Patent preparation and prosecution for large and small U.S. clients
- Preparation of validity and infringement opinions

Paul L. Brown

EDUCATION:

- A.B. Monmouth College, Chemistry 1961
- M.A. DePauw University, Physical and Organic Chemistry 1963
- J.D. University of Michigan, 1966

EMPLOYMENT:

- Emrich & Dithmar, Chicago IL, (1975-present)
- Fish & Neave, New York NY, Associate (1966-1972)
- Mueller & Aichele, Chicago IL, Associate (1973-1974)

LITIGATION EXPERIENCE:

- First Chair responsibility for 14 litigations that were either tried or settled after completion of pre-trial discovery.
- Recently tried and obtained \$2.5 million dollar judgment against the United States Postal Service in U.S. Court of Claims
- Recently obtained permanent injunction against web site infringer of client's trademark in U.S. District Court for the Eastern District of Massachusetts.
- Recently obtained \$3.0 million dollar judgment for Berkenhoff GMBH against an Indian corporation in U.S. District Court for the Southern District of Ohio
- Have tried/settled after completing pretrial discovery litigations involving wire dispensing apparatus, alloy coated welding wire compositions, agricultural implements, metal forgings, dye-based ink imprinting, molding of bottle caps, tire retread methods, medical pipette trays, tire shredders, portable floor cleaning machines, electrophotocopying processes and photoconductive materials, false twist polyester yarn process, photographic darkrooms, nanotechnology molding and medical biopsy devices.

PROSECUTION EXPERIENCE:

- Prepared and prosecuted in excess of 300 patents before the U.S. Patent Office.
- Prepared and prosecuted in excess of 200 trademarks before the U.S. Trademark Office.
- The bulk of the patents encompass the technologies of metallurgy, mechanical seals, bearings, rubber compositions, nuclear polymer interactions, rotary unions, regenerative turbine pumps, wire handling equipment and properties, medical products and chemical coatings and paints.
- Provide Patent Counsel for U.S. clients which include companies such as GE Betz, Exelon, Deublin Company, Paymaster Technologies.
- Specialized experience in infringement risk analysis, portfolio audits and patent mapping, technology licensing and protecting intellectual property assets.

BAR AND PROFESSIONAL ACTIVITIES:

- Admitted to practice before Eastern and Southern Districts of New York, Northern District of Illinois Eastern District of Iowa, Western District of North Carolina, Western District of Pennsylvania, District Court of South Carolina, Southern District of Ohio, District Court of Minnesota, District Court of Utah, First Circuit Court of Appeals, Second Court of Appeals, Fifth Circuit Court of Appeals, Sixth Circuit Court of Appeals, Seventh Circuit Court of Appeals and the Federal Circuit Court of Appeals, and Federal Circuit Court of Appeals

Laurence Joseph Marhoefer

EDUCATION:

B.S. Electrical Engineering, Villanova University
LLB Georgetown University

EMPLOYMENT:

- Snider & Associates, resident (2001-present)
- Lane, Aitken, and McCann, Partner (1989-2001)
- Unisys, Inc., Vice President, and Chief Patent Counsel (1985-1989)
- Honeywell, Inc., Vice President, and Chief Patent Counsel (1973-1985)
- Potter Instrument Co., General Counsel (1966-1973)
- U.S. Patent Office, Patent Examiner (1964-1966)

PROFESSIONAL EXPERIENCE:

- Engaged primarily in the preparation and prosecution of patent applications in the electronic and computer arts.

BAR AND PROFESSIONAL ACTIVITIES:

- Admitted to practice law in New York and Virginia
- Admitted to practice in U.S. Federal Court in New York
- Admitted to practice before U.S. Patent and Trademark Office
- Member, Association of Corporate Patent Counsels

Albert Tockman

EDUCATION:

B.S. Chemistry, City College of New York
M.S. Organic Chemistry, University of Kentucky
PHD Organic Chemistry, Northwestern University
LLB University of Maryland

EMPLOYMENT:

- Armstrong, Nakido....., Partner, chemical and pharmaceutical patent prosecution
- Stevens, Davis, Miller and Mosher, chemical and pharmaceutical patent prosecution
- Wegner and Bretschneider, chemical and pharmaceutical patent prosecution
- G.D. Searle Corp., Assistant General Counsel, patents and trademarks
- Stowell and Stowell, Partner, chemical and pharmaceutical patent law
- Lawrence and Lawrence, chemical and pharmaceutical patent law
- W.R. Grace Corp., research and development, synthetic compounds having pharmacological activity
- Mobay Corp., research and development, polymer chemistry

BAR AND PROFESSIONAL ACTIVITIES:

- Past Chairman of Chemical Practice Committee (1977-1978), American Patent Law Association (1977)
- Advisor to U.S. Delegation to Budapest Treaty concerning the deposit of microorganisms for patent purposes (1977)
- Patent Committee Chairman (1976-1977), Pharmaceutical Manufacturers Association

Jonathan Krit

EDUCATION:

- B.S. Industrial Engineering, Northwestern University, 1986
Tau Beta Pi Engineering Honor Society
Dean's List (3 Semesters)
Off Campus Students Association (President 1985)
- J.D. Northwestern University School of Law, 1989
Journal of Criminal Law and Criminology, Associate Executive Editor
Deans List (4 semesters)

EMPLOYMENT:

- Emrich & Dithmar LLC, Chicago, IL, (1993- present)
- Roper & Quigg, Chicago, IL (1990-1992)
- Neuman, Williams, Anderson & Olson, Chicago, IL (Summer 1988)

PROFESSIONAL EXPERIENCE:

- Involved in all aspects of intellectual property law, including patent and trademark litigation and proceedings before the Patent and Trademark Office.
- Draft pleadings, conduct discovery, and prepare motions and trial briefs.
- Technical Interests include computer and engineering science, computer interaction, and manufacturing systems

BAR AND PROFESSIONAL ACTIVITIES:

- Member, Trial Bar, Northern District of Illinois,
- Licensed to practice before U.S. Patent and Trademark Office
- Member, Chicago Bar Association
- Volunteer, Chicago Volunteer Legal Services (Panel Program),

SUMMARY OF LITIGATION CONDUCTED BY
RONALD R. SNIDER

General Electric Company v. The United States

191 USPQ 574 (Ct.Cl., 1976) (Trial Decision); and 572 F2d 745, 198 USPQ 65 (U.S.Ct.Cl. 1978) (Decision on Appeal). Procedural decisions: 184 USPQ 448 (Ct.Cl. Oct 25, 1974); 183 USPQ 354 (Ct.Cl. July 5, 1974); 182 USPQ 624, (Ct.Cl. May 8, 1974); 182 USPQ 44 (Ct.Cl. Feb 20, 1974), and **United States v. General Electric Co.**, 183 USPQ 551. (Comm. Pat & T.M. Decided Sept 18, 1974)

RESULT: WON for Defendant. Three patents were tried, two were found invalid at the trial level, and the third was found not infringed after appeal to the U.S. Court of Claims (now Federal Circuit).

PARTICIPATION: Lead counsel at trial for defendant, handled witnesses for all three patent defenses, and directed other attorneys. I left Department of Justice before appeal was briefed and argued. I was responsible for a part of pretrial procedure and discovery. Steven Kreiss was primarily responsible for the hydraulic servo patent and argued the entire case on appeal.

BACKGROUND: This case was brought by GE on 3 patents which were for basic developments made by GE prior to World War II. The case was tried in 1975, and decided on appeal in 1977. The long delay between filing of the patents and trial was caused by the withdrawal of these patents from issue because of national security. The patents were for servo mechanisms used to drive gun turrets, to direct radar antennas, and for missile guidance. The accounting period covered World War II, Korea and the Viet Nam build up. The total procurement was in the at least 100 billion dollars and the liability risk for the government was at least one billion dollars.

PRETRIAL AND TRIAL: Mr. Henderson of Finegan, Henderson, et. al. of Washington, D.C. was lead counsel for GE. He was supported by his own firm and by substantial efforts of house counsel, Mr. Irving Freedman. There was a long and acrimonious pretrial phase where there were many hearings and decisions by the Trial Judge, Joseph Colaanni (now with Pennie and Edmonds, Washington, D.C.). The trial lasted for approximately 7 weeks and included many witnesses who were leaders in the field of servo mechanisms. Two of the patents were held invalid because of prior art, and the third was held valid by the Trial Judge. The third patent was later held not infringed by the Court of Appeals on a theory of permissible repair of items purchased originally from General Electric. The repair evidence was presented by me at the trial level.

General Electric Company v. The United States

206 USPQ 260 (Ct.Cl. Oct 24, 1976) (Trial Decision); and 228 Ct.Cl. 192, 654 F.2d 55, 211 USPQ 867 (Ct.Cl. 1981) (Decision on Appeal). Procedural decision: 215 Ct.Cl. 928 (Ct.Cl. October 11, 1977).

RESULT: LOST for Plaintiff. A single patent on a viscous dampening system for small gyroscopic devices was found invalid for multiple reasons by Trial Judge Francis

Browne. The decision was affirmed only on a holding of invalidity based upon a prior on sale bar created by a third party (Nortronics). Plaintiff lost at trial and on appeal.

PARTICIPATION: Lead counsel for Plaintiff. I was retained as lead counsel by General Electric after discovery was closed. GE had originally proceeded with house counsel, and then decided to use outside counsel at trial. I tried case, briefed at the trial level, briefed and argued appeal

BACKGROUND: G.E. developed and patented its viscous damped gyroscope. A prototype design was offered to the government more than one year prior to the filing of the patent. Much of the trial was directed to an alleged on sale bar by GE, and a claim of fraud upon the Patent Office where testimony was presented in an interference record, but was not specifically brought to the attention of the examiner by the attorney for GE.

The third party (Nortronics) developed and offered for sale a prototype device which was held to anticipate the GE gyroscope invention. The issue was whether the Nortronics device was ever reduced to practice.

The procurement of alleged infringing devices was approximately 700 million dollars which could have resulted in compensation to GE in excess of 50 million dollars.

PRETRIAL AND TRIAL: Steven Kreiss represented the U.S., and John Nelson of the Allegretti firm represented Honeywell. GE failed to take discovery from the third parties, and Trial Judge Browne would not reopen discovery after I was retained. The trial took approximately one month. The appeal was en banc because of the unique holdings made by Judge Browne.

Gould, Inc. V. The United States

195 USPQ 112 (Ct. Cl. Oct 29, 1977) (Trial Decision); and 579 F.2d 571, 198 USPQ 156 (Ct. Cls., 1978) (Decision on Appeal).

RESULT: WON for Defendant. One patent was tried and held invalid at trial and the decision was affirmed. Plaintiff was held to have offered the patented device for sale to the United States more than one year before filing of the patent.

PARTICIPATION: Lead counsel for defendant. I handled all pretrial discovery and post trial briefs. The appeal was carried on by the Department of Justice after I resigned.

BACKGROUND: Gould was disappointed when it did not get production contracts and sued in the Court of Claims for damages. Gould developed a prototype of its Mark 46 torpedo engine and later patented the invention after further development under a government contract. Gould denied that the government had any license rights in the invention because it had been reduced to practice before entry into the contracts. Gould's unsolicited proposals to the government offering to produce the engine were more than a year before the filing of the patent application and created an on sale bar. Gould tried to argue that it could continue under the experimental use exception even though it had reduced to practice a primitive device.

PRETRIAL AND TRIAL: Gould was represented by William Schuyler and Paul Edgel of the Schuyler, Birch, et. al. firm. The case was filed and tried within one year because the parties cooperated in discovery and did not engage in delay tactics. The case was won by defendant when a vice president of Gould testified that he was well versed in marketing and that it was Gould's intent

to sell the patented engine. This testimony was obtained because discovery showed that he had an advanced degree in marketing. Discovery on intent to sell was avoided in order to surprise plaintiff at trial. The trial took two weeks before Judge Colaanni.

Rel Reves Inc. v. The United States

186 USPQ 21 (Ct.Cl Trial Div. 1975) (Trial Decision); 209 Ct. Cl. 595, 535 F.2d 274, 198 USPQ 384, (Ct.Cl. 1976) (Decision on Appeal).

RESULT: LOST for defendant. One patent for an analog circuit was found not to be licensed to the United States.

PARTICIPATION: Second chair for defendant at trial with C.L. Whitham as first chair. Mr. Whitham left the Department of Justice after the trial was completed. I was responsible for the post trial briefs and the appeal.

BACKGROUND: Case was brought by plaintiff to recover for infringement of a patent covering a checking circuit used in analog computers after the patent had been held valid and infringed by a California United States District Court in Dynamics Inc. v. Beckman Instruments, Inc. The government did not contest validity and infringement. The defense was limited to a claim of a license based upon prior government contracts with plaintiff. After an accounting trial, the government lost more than \$10,000,000.

PRETRIAL AND TRIAL: I entered the case before trial and participated in the discovery.

Karch v. The United States

195 USPQ 88 (Ct.Cl. Trial Div. 1977) (Trial Decision); and 198 USPQ 456 (Ct.Cl. 1977) (Decision on Appeal).

RESULT: WON for Defendant. One patent for a method and apparatus for agricultural flood control was tried and affirmed on appeal.

PARTICIPATION: Lead counsel for defendant. I conducted all discovery, the trial, and the post trial briefs. The appeal was carried on by the Department of Justice after I resigned,.

BACKGROUND: Plaintiff was an individual who was a contractor in Illinois. Claim was against the Department of Agriculture who had designed and subsidized construction of flood control devices on private farms. The claim against the government was brought because plaintiff lost private sales to the government program.

PRETRIAL AND TRIAL: Defenses were based upon prior public use and prior art. The trial lasted for at least 60 hours which were compressed into a 5 day time slot. Trial Judge Colaanni heard the case and held for defendant.

Mudny v. Link

Interference, The Board of Appeals and Court of Customs and Patent Appeals (1973) cases were not reported.

RESULT: WON for Junior Party. One patent for a hoist for retrieving objects from the ocean mounted on a pitching deck.

PARTICIPATION: Lead counsel for Junior Party. I took all testimony, briefed and argued the case at the Patent Office Board of Patent Interferences, and argued the appeal.

BACKGROUND: The junior party copied claims from the senior party and proved an actual reduction to practice several years in advance of the filing or reduction to practice by the senior party. The invention was for a crane which included guides for a cable to prevent loss of control when an object is hoisted from the water to the pitching deck of a ship. The party Link was the well known Edwin Link who is better known for the Link pilot trainers. Union Carbide was the assignee who prosecuted the interference for Link.

PRETRIAL AND TRIAL: Several volumes of testimony were taken by both sides. The prior reduction to practice was proven by convincing oral, photographic, and documentary evidence in accordance with Board of Interferences requirements for corroboration and authentication.

Everett C. Young v. The United States

204 Ct.Cl. 867, 179 USPQ 801, (Ct.Cl. Trial Div. 1974) (Trial Decision);
(and decision on Appeal--not reported)

RESULT: WON for Defendant. Two patents were held invalid.

PARTICIPATION: Lead counsel for defendant. I handled all discovery, the trial and appeal. Two patents for a re-entry heat shield used on the Mercury, Gemini, Apollo and Shuttle space craft.

BACKGROUND: Plaintiff was a private pro se inventor who did not understand the technology and prosecuted his own patents and this law suit. The case was a "nuisance case" where the government gave the plaintiff a complete day in court.

PRETRIAL AND TRIAL: Trial lasted 6 weeks. Testimony was taken from NASA celebrities including John Glenn, Mrs. John Glenn, "Shorty" Powers (voice of Mercury Program) and Max Faget (Director of Mercury Program).

Lemelson v. Mossinghoff

225 USPQ 1063, (D.D.C. 1985) (Trial Decision); and no appeal taken.

RESULT: WON for Plaintiff. This was a 35 USC Sec 145 action against the Commissioner of Patents to require reissue of Lemelson's "Hot wheels" patent. This

was Lemelson's first trial win.

PARTICIPATION: Lead counsel for plaintiff at trial. I entered the case after the briefs were filed at the Patent Office Board of Appeals, argued the Patent Office appeal, conducted discovery against the U.S. Patent Office and Mattel Corp. and tried the case before Norma Johnson in the U.S. District Court for the District of Columbia. Mr. William D. Hall assisted me on the case and at trial.

BACKGROUND: Lemelson had a case pending in Chicago against Mattel and several other manufacturers for infringement of his "Hot Wheels" patent. The court gave signals that it did not look with favor on Lemelson's case. Lemelson then took the case back to the Patent Office where he sought reissue. When the case was won in the District of Columbia, the Chicago case resumed, went to a jury and resulted in a \$70,000,000 judgment for Lemelson. The Federal Circuit ultimately reversed after Donald Dunner won the appeal for Mattel. Lemelson got nothing.

PRETRIAL AND TRIAL: Discovery was taken against the Commissioner to prove that Patent Office classification can be an indication of non-obviousness, and discovery was taken from Mattel to prove commercial success of the invention based upon Mattel's successful development, testing and marketing of the product. We used the infringement to prove non-obviousness. This evidence could not have been used before the Patent Office Board of Appeals because Lemelson could not get discovery in the *ex parte* proceeding. Former Commissioner Robert Gottschalk testified as an expert in patent law for Lemelson.

Trial subpoenas were issued against Mattel Corp after it was proven that the registered corporate agent for Mattel in Wilmington, Delaware was less than 100 miles from the United States District Court as the "crow flies."

The trial lasted 5 full days and was the first trial where the Commissioner of Patents called its own witness (supplied by Mattel).

Lemelson v. The United States et. al.

3 Ct.Cl 161, 223 USPQ 1183 (Ct.Cl. 1983) (Trial Decision); and 752
F.2d 1538, 224 USPQ 526 (Fed.Cir. 1985) (Decision on Appeal).

RESULT: INCONCLUSIVE. 3 patents were held not infringed, one reversed on appeal, settled for royalty free license to the United States.

PARTICIPATION: Second Chair. Mr. William Jackson (now with Larson and Taylor) was lead counsel. I handled direct and cross examination of hostile witnesses, Mr. Jackson presented our witnesses. The United States was represented by the Department of Justice, and Bendix Corporation and Brown and Sharpe were represented by Mr. John Kidd who was then with Pennie and Edmonds. Mr. William D. Hall was lead counsel in the appeal to the Federal Circuit.

BACKGROUND: Mr. Lemelson brought this action in the Court of Claims where multiple defendants could be tried in a single trial. Ultimately it was concluded that the Court of Claims was too slow in resolving the issues and that the recovery from the United States was so small that it did not justify further effort. The case was settled for no money after one patent was remanded back to the Trial Division for further proceedings by the Federal Circuit.

PRETRIAL AND TRIAL: Trial required 4 weeks where only evidence of infringement was received; the

court granted a motion for judgment at the end of plaintiff's case on the ground of non-infringement. This was reversed on the electrical patent only, and the case was remanded for further proceedings.

Lemelson v. The United States, et al.

14 Ct.Cl. 318, 6 USPQ 2d 1657, (Ct. Cl. 1988); and no appeal was taken

RESULT: WON a motion for summary judgment (non-infringement) brought by the defendants. After remand, the case was settled with Cincinnati Millicron, and the United States and dropped with respect to DeVilbus.

PARTICIPATION: Lead counsel for plaintiff. I entered the case after the briefs were filed and argued the case at several hearings. I participated in some discovery depositions and pretrial procedures.

BACKGROUND: This case was brought by Mr. Lemelson to establish several of his industrial robot patents. The case was brought against the government in order to bring in multiple defendants. Subsequently Lemelson obtained a \$15,000,000 judgment against DeVilbus which was affirmed by the Federal Circuit.

PRETRIAL AND TRIAL: Decided on summary judgment motion to dismiss.

**Intertech Licensing Corporation v. Brown and Sharpe
Manufacturing Company, Inc.**

708 F.Supp. 1423, 11 USPQ 2d 1258 (D.Del., 1989) (Trial Decision); and no appeal was taken (a Lemelson case)

RESULT: LOST summary judgment motion after limited trial on a laches defense.

PARTICIPATION: Lead counsel at trial, handled discovery.

BACKGROUND: This case was a continuation of Lemelson v. United States, 3 Ct.Cl. 161, 223 USPQ 1183 (Ct.Cl. 1883) (see above) where Lemelson pursued Brown and Sharpe into the Delaware District Court.

PRETRIAL AND TRIAL: One day Trial before Judge Latchum, and discovery on laches only.

Pratt & Whitney Canada Inc. v. The United States

12 Ct. Cl. 221, 2 USPQ 2d 1540 (Ct.Cl. 1987); and no appeal was taken.

RESULT: LOST summary judgment motion for holding that United States Government could not raise a laches defense. An action to enforce a protective order was brought

by General Electric Company against plaintiff and counsel for plaintiff which resulted in a settlement which included transfer of the case to Brumbaugh Graves et al in New York. The main patent infringement case was lost on validity after trial by Robert Neuner of Brumbaugh, Graves et. al.

PARTICIPATION: I was second chair and Barry Bretschneider was lead counsel when the case was with Wegner and Bretschneider of Washington D.C. I was responsible for infringement discovery and rebuttal to prior art defenses

BACKGROUND: Case was brought by Pratt and Whitney of Canada for infringement of a basic patent on a diffuser used in a centrifugal compressor stage of small gas turbine engines.

PRETRIAL AND TRIAL: I took discovery on infringement, copying, and development of the accused engine by the General Electric Company.

Vincent Bly v. Banbury Books, Inc. and Acorn Software Products

638 F.Supp.983, 231 USPQ 404 (E.D. Pa. 1986) (Trial Decision); and no Appeal was taken.

RESULT: WON summary judgment for Plaintiff in copyright infringement case.

PARTICIPATION: Lead counsel for Plaintiff. I conducted the discovery and prepared all motion papers.

BACKGROUND: A simple action for copyright infringement where statutory damages were sought

PRETRIAL AND TRIAL: prepared and filed briefs and written discovery.

Intertech Licensing Corporation v. DEA Inc.

Unreported Decisions of U.S. District Court for Michigan and the Federal Circuit (a Lemelson case).

RESULT: LOST the appeal of a summary judgment decision from the United States District Court in Michigan. The Federal Circuit (Judge Markey) considered the appeal to be frivolous and awarded costs and attorney fees to winning party.

PARTICIPATION: I entered this case after the briefs were filed and the issue was joined in Michigan. I prepared and argued the appeal.

BACKGROUND: This case was a follow on case of Lemelson v. United States, 3 Ct.Cl 161, 223 USPQ 1183 (Ct.Cl. 1883) (see above), where Lemelson sought damages for DEA's direct infringement.

PRETRIAL AND TRIAL: I did not participate in the District Court proceedings. I briefed and argued the appeal.

Summa Four Corporation and Aspect Telecommunications, Inc.
v. Omnitel Corporation

No reported decisions, U.S. District Court for New Hampshire, 1992.

RESULT: WON by obtaining a \$1,700,000 settlement from Summa Four and Aspect.

PARTICIPATION: I was lead counsel for plaintiff in all discovery and pretrial proceedings.

BACKGROUND: Plaintiff (Omnitel) had transferred technology to Summa Four and licensed them to practice a telephone switch patent. Summa Four then resold the technology to Aspect who did not know about the patent or the prior technology transfer. A declaratory judgment action was brought on the patent by Summa Four, and Omnitel counterclaimed for patent damages and for breach of contract. Aspect was then sued in the Eastern District of Virginia by Omnitel. The cases were consolidated in New Hampshire.

TRIAL: Settled four days before scheduled trial after all preparation was complete. The case was settled after the jury was selected.

Larson v. The United States

24 USPQ 2d 1388 (Ct.Cl. 1992) (Partial Summary Judgment). No Appeal.

RESULT: LOST summary judgment motion brought by Larson. We obtained a Settlement for \$80,000 with United States and the third parties.

PARTICIPATION: Initiated suit, lead counsel during pretrial, prepared and filed briefs on partial summary judgment on whether the United States is liable for use of a patent in the Medicare and CHAMPUS health care programs.

BACKGROUND: Contingent fee case, patent for a splint which used a heat setting plastic. The patentee was a chemistry professor at the University of Delaware who developed the technology while he was with DuPont.

PRETRIAL AND TRIAL: I directed discovery and summary judgment preparation.

Paymaster v. The United States

RESULT: WON by obtaining a \$2,500,000 judgement in a single trial covering all liability issues and the accounting. Now on appeal at the Federal Circuit.

PARTICIPATION: Assisted Mr. Paul Brown of the firm of Emrich & Dithmar, located in Chicago, Illinois.

30. This doctrine of prosecution history estoppel was more recently affirmed in *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 219 USPQ 473 (Fed. Cir. 1983). As Chief Judge Markey stated in that case:

The doctrine of prosecution history estoppel precludes a patent owner from obtaining a claim construction that would resurrect subject matter surrendered during prosecution of his patent application. The estoppel applies to claim amendments to overcome rejections based on prior art, *Dwyer v. United States*, 357 F.2d 978, 984, 149 USPQ 133, 138 (Ct. Cl. 1966), and to arguments submitted to obtain the patent, *Coleco Industries, Inc. v. ITC*, 573 F.2d 1247, 1257, 197 USPQ 472, 489 (C.C.P.A. 1978).

31. There is no infringement if the accused device omits even a single element of the claim at issue, even though the same results are achieved. *Minnesota Mining & Mfg. Co. v. Permacel-LePage's, Inc.*, 334 F.2d 820, 823, 142 USPQ 57, 59 (7th Cir. 1964) [Attachment 18]; *Ebeling v. Pak-Mor Mfg. Co.*, 683 F.2d 909, 913, 216 USPQ 563, 567 (5th Cir. 1982) [Attachment 40].

32. Claim 1 of the '864 patent is not infringed by defendant's accused extrusion fusion welders.

Award of Attorneys Fees

33. The Court may award reasonable attorneys' fees to the prevailing party in an exceptional case. See, 35 U.S.C. §285. The Court finds that upon consideration of the evidence of the conduct of both plaintiff and defendant herein, that this is not an exceptional case within the meaning of 35 U.S.C. §285; therefore, the defendant is not entitled to an award of reasonable attorneys' fees. Both sides are to bear their own costs of this litigation.

34. Any conclusion of law herein which may be properly construed in whole or in part as a finding of fact, shall be so deemed and treated as if set forth under the Findings of Fact above.

District Court, District of Columbia

Lemelson v. Mossinghoff

No. 83-0217

Decided Mar. 26, 1985

PATENTS

1. Patentability — New use or function — Nonanalogous art (§51.557)

Marble raceway art is not analogous to toy vehicle trackway art.

2. Patentability — Evidence of — In general (§51.451)

New evidence including testimony from expert and from the inventor who is skilled in art, documentary evidence and testimony of nonanalogous nature of reference, and evidence of great commercial success of product covered by reissue application, which was first introduced at trial but was not intentionally or negligently withheld from PTO, and that was of such character and amount as to carry thorough conviction of error, warrants conclusion that modification of trackway for toy vehicles was not obvious.

Particular patents — Toys

3,451,161, Lemelson, Toy Track Vehicle Therefor, holding of invalidity of claims 1-3, 6-9, and 12-18, of reissue application reversed.

Action by Jerome H. Lemelson, against Gerald Mossinghoff, Commissioner of U.S. Patent and Trademark Office, under 35 USC 145. Judgment for plaintiff.

Ronald R. Snider, Washington, D.C., for plaintiff.

Fred E. McKelvey, Associate Solicitor, for defendant.

Johnson, District Judge.

Memorandum Opinion

Plaintiff Jerome H. Lemelson instituted this action under 35 U.S.C. §145 (1982) on January 26, 1983. He challenges the November 30, 1982, decision of the Board of Appeals of the United States Patent and Trademark Office (PTO) denying his reissue application for a "Toy Track Vehicle Therefor." This matter was tried before the Court. This memorandum opinion constitutes the Court's final findings of fact and conclusions of law. For the reasons stated herein the Court will enter judgment for plaintiff because his invention "as a whole would [not] have been obvious at the time the invention was made to a person having ordinary skill in the [trackway-toy-vehicle] art." The Court further rules as a preliminary matter that the following exhibits introduced by plaintiff at trial are admissible: 1) exhibits regarding the commercial success enjoyed by Mattel, Inc. from its "Hot Wheels" track and 2) exhibits regarding the scope and content of the prior

art. Defendant objected at trial to the admission of these exhibits on the ground that they either constitute irrelevant or new evidence which plaintiff neglected to present to the PTO or raise new issues and new facts. The Court disagrees. It is well established that an action in the district court under 35 U.S.C. §145 is a proceeding de novo and while it is limited to the invention claimed in the PTO, the Court may consider any additional, competent evidence which a plaintiff neither intentionally nor negligently failed to submit to the PTO. See, e.g., *California Research Corporation v. Ladd*, Commissioner of Patents, 356 F.2d 813, 144 USPQ 524 (D.C. Cir. 1966); *Schindler v. Commission of Patents*, 269 F.Supp. 630, 153 USPQ 838 (D.D.C. 1967); *Gusmer v. Parker*, Acting Commissioner of Patents, 206 USPQ 991, 996 (D.D.C. 1980); *Knutsen v. Gallsworthy*, 74 USPQ 324 (D.C. Cir. 1947). Plaintiff's exhibits 2B-2E, 2H, and Lemelson's testimony regarding exhibits 2A, 3 and 3A, which are respectively new demonstrative evidence and new expert-witness testimony, were neither intentionally nor negligently withheld in the PTO §145 proceedings. Similarly, the new evidence of Mattel's sales data was not intentionally nor negligently withheld by plaintiff during the PTO proceedings as it was not in his custody, control, or knowledge at that time. See e.g., *Velsicol Chemical Corp. v. Monsanto Co.*, 579 F.2d 1038, 198 USPQ 584 (7th Cir. 1978). Finally, the Court finds that plaintiff's exhibits 8A-8D, 12A-12B, and 14 neither raise new issues nor new facts and exhibits 2 and 13 are relevant to the issue of commercial success.

Findings of Fact

1. Plaintiff Jerome E. Lemelson is a resident of New Jersey.

2. The defendant Gerald Mossinghoff is the Commissioner of U.S. Patent and Trademark Office (PTO) and by virtue of that office is a resident of the District of Columbia.

3. The Court has jurisdiction over the parties to this action and the subject matter under 35 U.S.C. §145 (1982).

4. Plaintiff is the inventor of the invention disclosed and claimed in U.S. Patent No. 3,451,161 (Lemelson '161).

5. On December 16, 1980, plaintiff filed an application in the PTO pursuant to 35 U.S.C. §251 and 37 C.F.R. 1.175(a)(4) (Reissue Application) to reissue the Lemelson '161 patent and the application was assigned Serial No. 216,920. (PX-20, p. 1 et seq.).

6. The Reissue Application was protested by Mattel, Inc., inter alia, under 37 C.F.R. 1.219(a). (PX-20).

7. Patent Officer Examiner and the PTO Board of Appeals, acting for defendant, disallowed claims 1-3, 6-9, and 10-19 of the Reissue Application holding them unpatentable under 35 U.S.C. §103. Pursuant to the provisions of 35 U.S.C. §145, plaintiff filed a complaint with this Court seeking an order authorizing the Commissioner of Patents to grant a Reissue Patent including claims 1-3, 6-9, and 11-19 of his Reissue Application, (PX-20, pp. 33-40, 90-106, 149-67).

8. Plaintiff no longer seeks relief with respect to claims 1,2,4,5, and 19. (J.S.b).

9. The Patent Examiner held and the Board of Appeal affirmed that claims 1-3, 6-9, and 12-19 were unpatentable under 35 U.S.C. §103 based upon the following prior art: U.S. Patent No. 2,574,067 (Seidman patent); U.S. Patent No. 2,532,521 (Stair patent); U.S. Patent No. 2,068,403 (Ekstrom patent), and British Patent Specification No. 489,503 (Smallwood patent). (PX-20, pp. 38, 103-06).

10. The Patent Examiner held and the Board of Appeals affirmed that claims 10 and 11 were unpatentable under 35 U.S.C. §103 based upon the following prior art: Seidman, Stair, Ekstrom, Smallwood patents; U.S. Patent No. 2,062,333 (Gardioli patent); and U.S. Patent No. 3,016,845 (Lemelson '845 patent). (PX-20, pp. 162-66).

11. The subject matter of the Reissue Application is a non-self supporting flexible track for toy vehicles. The track is composed of flexible thermoplastic resinous polymer selected from the group consisting of polyethylene, polyvinyl chloride, and acetate resin.

12. The claims in dispute read as follows:

Claim 3: A trackway toy comprising in combination with a toy vehicle having plural wheels, a trackway including a base having an upper surface along which said vehicle may travel, guide means for defining a path of travel for said vehicle on said upper surface, said guide means including a [sic] least one formation molded integrally with said upper surface of said vehicle may ride to define said path of travel therealong, said base and said guide means being integrally molded of flexible plastic material and having the characteristic such that said base is normally incapable of self-support whereby said trackway will easily conform to non-planar surfaces and rigid support mean for said trackway disposed adjacent said base and engaging a surface thereof in a manner to predetermine the shape of the base, said guide means include a pair of spaced apart runner portions for

defining the pathway of a vehicle moving over said track, said spaced apart runner portions include upwardly extending rails for guiding the wheels of a vehicle.

Claim 6: A trackway toy comprising in combination with a toy vehicle having plural wheels, a trackway including a base having an upper surface along which said vehicle may travel, guide means for defining a path for travel for said vehicle on said upper surface, said guide means molded integral with said upper surface of said trackway and providing surface means against which respective wheels of said vehicle may ride to define said path in travel therealong, said base and said guide means being integrally molded to flexible plastic material and having the characteristic such that said base is normally incapable of self-support whereby said trackway will easily conform to non-planar surfaces and rigid upright support means for suspendingly supporting said trackway therefrom in a manner to predetermine the shape of the base, said rigid upright supports comprising a supporting said track in suspension between said rigid uprights.

Claim 7: A trackway toy in accordance with claim 3 wherein said spaced apart runner portions extend the length of said trackway along the lateral borders of the trackway.

Claim 8: A trackway toy in accordance with claim 3 wherein said rigid support means supports said trackway in a manner to cause curved deflection of said trackway and to impart an arcuate shape thereto.

Claim 9: A trackway toy in accordance with claim 8 wherein said curved deflection of said trackway is affected by the weight of said trackway.

Claim 10: A trackway toy in accordance with claim 3 wherein said base has a central portion of flat sheet-like configuration and said spaced-apart runner portions extend upwardly from the upper surface of said flat sheet-like central portion and parallel to each other.

Claim 11: A trackway toy in accordance with claim 10 wherein said spaced apart runner portions extend the length of said trackway along the lateral borders of the trackway.

Claim 12: A trackway toy in accordance with claim 3 including fastening means securing said trackway to said rigid support means.

Claim 13: A trackway toy in accordance with claim 12 wherein said fastening means secures said trackway to said rigid support means at a location such that said trackway becomes arcuately curved in de-

flection downwardly from said rigid support means, under its own weight.

Claim 14: A trackway toy in accordance with claim 3 wherein said trackway is formed of thermoplastic resinous polymer selected from the group consisting of polyethylene, polyvinyl chloride and acetate resin.

Claim 15: A trackway toy in accordance with claim 3 wherein said trackway is formed of an extrusion of a plastic resin of substantially constant cross section and selected from the group consisting of polyethylene, polyvinyl chloride and acetate resin and wherein said extrusion is so configured as to permit said trackway to arcuately deform downwardly under its own weight when supported by said rigid support means.

Claim 16: A trackway toy in accordance with claim 3 wherein said trackway is configured and formed of a plastic material imparting such characteristics thereto that the trackway may be twisted laterally with respect to its longitudinal axis.

Claim 17: A trackway in accordance with claim 16 wherein said trackway is supported by and attached to said rigid support means in a manner to impart a lateral twist thereto to permit a vehicle traveling along said trackway to bank in its travel along said trackway.

Claim 18: A trackway toy in accordance with claim 3 wherein the wheels of said vehicle are adapted to ride inwardly of said upwardly extending rails defining said spaced apart runner portions of said guide means for said vehicle. (PX-20, pp. 24-28).

14. The Seidman reference relates to flexible toy track structures for toy vehicles. The track lies on a support and has a pliant core that enables it to assume various shapes. A toy vehicle is guided on the Seidman track by means of the gravity centering of the wheels as opposed to wheel engagement when rails are used to guide the vehicle. (PX-20; Lemelson Tr. 97-103, 207-74, 284; Gottschalk Tr. 396).

15. A "Hot Wheels" type vehicle will slide on its side when placed on the Seidman track because of the guidance principle employed by Seidman. When the Seidman track is shaped to simulate a hill the pliant core in the track causes a "Hot Wheels" type vehicle to jump the track approximately 80 to 90 percent of the time. (Lemelson Tr. 137-39 and demonstration; Lemelson Tr. 132).

16. The Stair reference relates to a marble trackway. The track is composed of rubber or rubber composition extruded to form a base and a pair of upwardly projecting, diverging

flangs, creating a groove which the ball traverses. Stair discloses that a wire stiffener holds an inclined track rigid and straight. The Stair patent discloses further that the ends of track sections C and D are detachable and connectable by wire rods and "being flexible, may be laid in any shape or course on the floor or ground, over small blocks or the like in simulation of overpasses, and the end of the track opposite the inclined end, may terminate above base 10." The Stair patent discloses the use of a V-shaped groove in the track. (PX-20, p. 177, col. 2, lines 20-33, 37-42; Lemelson Tr. 108).

17. The Stair patent does not disclose the use of a toy vehicle, a toy vehicle on a trackway, or a guidance mechanism or principle for a toy vehicle on a trackway. The stiffening materials used in the Stair patent are not members of the group having pliable characteristics. (Lemelson Tr. 108, 109).

18. The subject matter of the Ekstrom reference is a self-propelled toy vehicle and a trackway. The vehicle is guided by a centrally located guide slot which guides the guide wheel of the vehicle. (PX-20, pp. 179-82).

19. The Smallwood publication discloses a flexible fabric track for electrically driven toy vehicles. (PX-20, pp. 183-86).

20. The Gardiol reference discloses a toy combination having a flat central portion on which a toy vehicle rides between parallel, upwardly extending walls. The trackway is composed of plastic material capable of undergoing a three-dimensional deformation (PX-20, pp. 187-88).

21. The field of art for plaintiff's claimed invention is trackways for wheeled toy vehicles; i.e., the trackway toy vehicle art.

22. The Patent Office classification for the trackway toy vehicle art is class 238, subclass 10. The Patent Office classification for the marble raceway art, which is disclosed in the Stair patent, is class 46, subclass 43. (PX-8C; Earls, Tr. 26).

23. The definition of patents in class 46, subclass 43 is "devices *** including runways for balls, marbles, or similar articles. Such devices usually have means for regulating and controlling the flow of such articles." (PX-8D).

24. Classification definitions are based upon particular properties and not accidents. The definitions of class 238, subclass 10 and class 46, subclass 43 are not cross-referenced. (PX-8C, p. 20-21; PX-8D).

[1] 25. A person of ordinary skill in the trackway toy vehicle art would not look to the marble raceway art disclosed in the Stair patent for guidance in vehicle track design. The Stair reference is selected from the non-analogous art of marble raceways. The mate-

rial difference between the Seidman reference and claims 3, 6-9, and 12-18 of plaintiff's Reissue Application is that plaintiff's claimed invention discloses a highly flexible trackway incapable of self-support whereas the Seidman patent discloses the use of a pliant core member to achieve the shape of the track. (PX-20, pp. 162-68).

26. No flexible tracks incapable of self-support for wheeled toy vehicles were in or taught by the prior art before May 5, 1967, and the Lemelson 161 patent is entitled to a filing date no earlier than May 4, 1967. (Gottschalk Tr. 422; J.S. 1).

27. The material difference between plaintiff's claimed invention and the Gardiol and Ekstrom references is that plaintiff does not include the use of stiffeners whereas the Gardiol and Ekstrom references disclose the use of stiffeners in the track. (PX-5A, PX-6).

28. The Smallwood reference discloses a pliant track but does not teach incapability of self-support. (PX-6).

29. The commercial success of the apparatus covered by claims 3, 6-9, and 10-18 is evidenced by the great commercial success of the Mattel, Inc., Hot Wheels flexible track, U.S. Patent No. 3,487,999, which is covered by the claims in plaintiff's Reissue Application. For the years 1968 to 1972 and 1974 to 1979, the total sales of items including the Mattel Hot Wheels track was at least \$77,996,756.20. (Gottschalk Tr. 406; PX-2, 2B, 2A, 3, and 3A; Lemelson Tr. 52-96; Newman Tr. 575; PX 7, 7A, 7B; Booriak 505). The commercial success of the Mattel Hot Wheels track was achieved largely by the proven "play value" to children of the flexible track-toy vehicle combination covered by plaintiff's Reissue Application; i.e., the more track used, the greater the play value. (PX-7, R/N-20 to 71).

30. Plaintiff's invention covered by Patent No. 3,451,161 has made a substantial advance to the art.

Conclusions of Law

1. This is an action under 35 U.S.C. §145. The Court has jurisdiction over the subject matter and the parties and venue are proper.

2. Plaintiff, as patentee of Patent No. 3,451,161, filed an application to reissue that patent in accordance with the Patent Laws, 35 U.S.C. §251.

3. The Commissioner of Patents disallowed plaintiff's claims 1-3, 6-9, and 10-19 of the Reissue Application. The purpose of this action is to determine whether the Commissioner erred in refusing to grant a Reissue Patent.

4. The presumption of correctness which attaches to the decision of the Commissioner is a rebuttable presumption that may be overcome by the introduction of evidence, at a trial under 35 U.S.C. §145, which is of such character and amount as to carry a thorough conviction of error. *Gusmer v. Parker*, 206 USPQ 991 (D.D.C. 1980).

5. A trial under 35 U.S.C. §145 is a trial de novo, and plaintiff and defendant may present evidence on any issue properly before the Court. *De Seversky v. Brenner*, Commissioner of Patents, 424 F.2d 857, 164 USPQ 495 (D.C. Cir. 1970); *New Wrinkle v. Coe*, 31 F.Supp. 415, 45 USPQ 69 (D.D.C. 1940). This additional evidence may include testimony of expert witnesses, an inventor skilled in the art, and evidence of commercial success. See *Scandiamant Aktiebolag v. Commissioner of Patents*, 509 F.2d 463, 184 USPQ 201 (D.C. Cir. 1974); *Charvat v. Commissioner of Patents*, 503 F.2d 138, 182 USPQ 577 (D.C. Cir. 1974).

6. Evidence introduced by plaintiff at trial but not considered by the Commissioner of Patents is of such character and amount as to carry a thorough conviction of error in the decision of the Commissioner rejecting plaintiff's application for reissue. This evidence included (a) testimony of Robert Gottschalk who is qualified as an expert witness; (b) the testimony of plaintiff Lemelson, who is both skilled in the art and the inventor, regarding the coverage of the Mattel, Inc., Hot Wheels track by claims 3 and 6 to 18 of the Reissue Application; (c) documentary evidence and testimony from the Patent Office showing the non-analogous nature of the Stair reference; (d) documentary evidence and testimony of witnesses from Mattel, Inc.; and (e) evidence that at least \$77,996,756.20 of track products covered by the Reissue Application were sold by Mattel, Inc.

7. The issue of obviousness or nonobviousness is a question of law and the United States Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) set forth the guidelines for making this determination under 35 U.S.C. §103; viz., to determine the scope and content of the prior art, to ascertain the differences between the prior art and the claims in issue, to resolve the level of ordinary skill in the art, and against these factors, to determine the obviousness or nonobviousness of the subject matter involved. In deciding the question of obviousness, the Court has considered the claimed invention as a whole. *Stratoflex, Inc. v. Aeroquip Corp.*, 218 USPQ 871 (Fed. Cir. 1983).

8. A person of ordinary skill in the art has knowledge of the prior art. *Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976).

[2] 9. The Court concludes as a matter of law that it would not be obvious under 35 U.S.C. §103 to modify the trackway disclosed in the Seidman patent to include the claimed concept of a track incapable of self-support when also considering the Stair, Ekstrom, Smallwood, Gardiol, and Lemelson 845 references. In making this determination, the Court recognizes the non-analogous nature of the Stair reference; the lack of teaching or suggestion in the prior art of the useful advantage of a flexible track incapable of self-support; and the commercial success of the highly flexible Hot Wheels trackway toy vehicle combination covered by plaintiff's Reissue Application.

10. In support of the conclusion that claims 3, 6-9, and 12-18 are non-obvious under 35 U.S.C. §103, the Court relies upon the fact that neither Seidman, Ekstrom, Smallwood, nor Gardiol include a suggestion to make a flexible track incapable of self-support or the advantage in their combination.

11. The fact that the claimed invention seems simple and when viewed in hindsight appears to be obvious is not enough to negate invention. *Goodyear Tire and Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 60 USPQ 386 (1944); *Gusmer v. Parker*, 206 USPQ 991, 997 (D.D.C. 1980). Simplicity by itself does not negate patentability. *Gusmer*, 206 USPQ at 997.

12. The non-obviousness of plaintiff's invention is evidenced further by the great commercial success of Mattel's Hot Wheels track toy vehicle combination covered by claims 3, and 6 to 18 of the Reissue Application. *Saf-Gard Products, Inc. v. Service Parts, Inc.*, 532 F.2d 1266, 1273, 190 USPQ 455, 460 (9th Cir. 1976). The fact that the Hot Wheels flexible track, U.S. Patent No. 3,487,999, is the one item which has been continuously manufactured and commercially sold by Mattel at a significant profit for the past 15 years demonstrates that the commercial success of the track covered by the claims in plaintiff's Reissue Application was due substantially to its own merits and play value.

13. Claims 3, 6-9, and 10-18 are not rendered obvious under 35 U.S.C. §103 by the prior art of record.

14. All of Claims 3, 6-9, and 10-18 are therefore patentable under 35 U.S.C. §103 and plaintiff is entitled to a reissue patent containing these claims.

An Order consistent with this Memorandum Opinion will be entered on this date.

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